

#3:

PATENT
38-21(10525)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Robert T. FRALEY et al.

SERIAL NO: 07/625,637

FILED: December 7, 1990

TITLE: CHIMERIC GENES FOR
TRANSFORMING PLANT
CELLS USING VIRAL
PROMOTERS

)
)
) GROUP ART UNIT: 184
)
) EXAMINER: David T. Fox
)
) August 21, 1992
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Commissioner of Patents and Trademarks,
Washington D.C., 20231 on August 21, 1992

Lawrence M. Lavin, Jr.

Registration No. 80,768

Lawrence M. Lavin, Jr. Date: Aug 21, 1992

PETITION TO CORRECT INVENTORSHIP

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

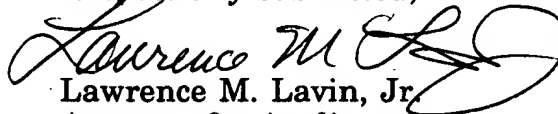
Applicants hereby petition under 37 C.F.R. 1.48 to correct the inventorship of this application. Accompanying this petition is a Declaration of Robert T. Fraley and Stephen G. Rogers setting forth the the facts establishing when the error in naming the incorrect inventorship occurred and how it occurred, showing that it occurred without deceptive intention. Also accompanying this petition are a declaration by each of the actual inventors under 37 C.F.R. 1.63 and a written consent of the assignee.

Correction of inventorship of an application should be granted as long as the error in naming the wrong inventorship occurred without any deceptive intention on the part of the actual inventors. 37 C.F.R. § 1.48(a). Indeed, if unclaimed subject matter is disclosed in an application that is invented by another, the application inventorship can be amended when the subject matter is claimed. 37 C.F.R. § 1.48(c). Here, the contribution of Horsch had always been disclosed in the parent and continuation applications, but was not claimed until the '568 application was filed. Applicants recognized the contribution of Horsch in view of the '402 application, which had claims directed to a method of producing differentiated plants and differentiated plants per se. Applicants did not recognize that by amending the claims to include claims to differentiated plants that the inventorship should also be amended until this was explained to applicants by their attorney in preparation for the preliminary statement and motions in Interference 102,890.

The error thus arose without any deceptive intent on the part of the actual inventors as required by Rule 48. It is therefore requested that this motion should be granted.

Please charge the fee set forth in 37 C.F.R. 1.17(h) to Deposit Account No. 13-4125. Please charge any additional fees associated with this petition or credit overpayment to the above-identified Deposit Account.

Respectfully submitted,


Lawrence M. Lavin, Jr.
Attorney for Applicants
Registration No. 30,768

Monsanto Company BB4F
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St. Louis, Missouri 63198
(314) 537-6670

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Lawrence M. Lavin, Jr.
Registration No. 30,768

Lawrence M. Lavin, Jr.

Date: *Aug 21, 1992*

DECLARATION OF ROBERT T. FRALEY AND STEPHEN G. ROGERS

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

We, Robert T. Fraley and Stephen G. Rogers hereby declare as follows:

1. On January 17, 1983, three applications were filed, U.S. Serial No. 458,414 ("the '414 application"), which listed as inventors Robert T. Fraley and Stephen G. Rogers; U.S. Serial No. 458,411 ("the '411 application"), which listed as inventors Robert T. Fraley and Stephen G. Rogers; and U.S. Serial No. 458,402 ("the '402 application"), which listed as inventors Robert T. Fraley, Stephen G.

Rogers and Robert B. Horsch. Each application incorporated the other application by reference. The '414 application originally claimed, *inter alia*, chimeric genes. The '411 application originally claimed, *inter alia*, a chimeric piece of DNA or a plasmid. The '402 application originally claimed, *inter alia*, a method of creating transformed plant cells and differentiated plants.

2. On April 15, 1983, U.S. Serial No. 458,568 ("the '568 application") was filed as a continuation-in-part application of the '414 application. This application incorporated the '414 application by reference. This application as originally filed contained a dependent claim directed to a differentiated plant.

3. On November 17, 1986, U.S. Serial No. 931,492 ("the '492 application") was filed as a continuation-in-part application of the '568 application. This application also incorporated the '568 application by reference. The '492 application as originally filed contained independent claims directed to differentiated plants.

4. On December 7, 1990, U.S. Serial No. 625,637 ("the '637 application") was filed as a file wrapper continuation of the '492 application. This application is the application of party Fraley et al. which is subject to the present interference.

5. A continuation application of the '411 application was filed on October 4, 1985 (U.S. Serial No. 783,336) and a continuation application of the '402

application was filed on October 30, 1985 (U.S. Serial No. 793,486). The prosecution of both of these cases has been suspended pending the declaration of one or more interferences.

6. In reviewing the '637 application in preparation for the preliminary motion stage of the present interference, our attorney recognized that claims 10-18 did not correspond to the count (See Fraley's Motion No. 5). Moreover, it was recognized that claims 16-18, which are directed to differentiated plants, were invented by the same inventive entity as the '402 (and thus, the 793,486 application), i.e., Fraley, Rogers, and Horsch.

7. We are the inventors of chimeric genes containing either the 35S and 19S promoter, and are the inventors of plasmids containing these chimeric genes. Horsch's contribution was in selecting and regenerating differentiated plants containing the chimeric genes invented by us. The contribution of Horsch was always recognized by the fact that Horsch was listed as a joint inventor in the '402 application. This disclosure was incorporated by reference into the '414, '568, '492 and '637 applications, but it was not recognized by us that by introducing claims to differentiated plants containing chimeric genes in the '568, '492 and '637 applications that Horsch should also be listed as an inventor in these applications until we were informed of that fact by our attorney in preparation of the preliminary statements and motions in the present interference.

8. We reviewed the '568 and '492 applications and executed declarations for those applications in the belief that these applications claimed only our contributions, and that we were the sole joint inventors. It was not until it was explained by our attorney in review of the application for the interference that our mistake was recognized by us. This was the first time that it was recognized by us that by amending the claims to include differentiated plants that the claims then included the contribution of Horsch and that it was necessary to change the inventive entity.

9. We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing thereon.

Date:

Aug 20, 1992

Robert T. Fraley
Robert T. Fraley

Date:

Aug 19 1992

Stephen G. Rogers
Stephen G. Rogers

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Lawrence M. Lavin, Jr.

Registration No. 30,768

Date: Aug 21, 1992

CONSENT OF ASSIGNEE

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Monsanto Company is the assignee of the above referenced
application, as demonstrated by the assignment recorded February 24, 1987 at
Reel No. 4673, Frame No. 843. Monsanto Company consents to the change of
inventorship in this application from Robert T. Fraley and Stephen G. Rogers to
Robert T. Fraley, Robert B. Horsch and Stephen G. Rogers.

Signed at St. Louis, State of Missouri, this 20th day of August, 1992.

MONSANTO COMPANY

By

Dennis R Hoerner

Associate Patent Counsel

Monsanto Company
800 North Lindbergh
St. Louis, Missouri 63167